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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,379	08/02/2006	Tomas J. Ekstrom	2836-0163PUS1	8424
2292 7590 07/22/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
EPFS -SMITH, JANET L				
ART UNIT		PAPER NUMBER		
1633				
NOTIFICATION DATE		DELIVERY MODE		
07/22/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**Office Action Summary****Application No.**

10/588,379

**Applicant(s)**

EKSTROM ET AL.

**Examiner**

Janet L. Epps-Smith

**Art Unit**

1633

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-68 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 2-11, 13-20, 32-61 and 64 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4-27-2009.

2. Applicant's election with traverse of Group 7, drawn to claims 21-25 and linking claims 1, 12, 21-31, 62-63, and 65-68, in the reply filed on 4-27-2009 is acknowledged. The traversal is on the ground(s) that there exists no undue administrative burden placed upon the examiner to search and consider all claims in their entirety. Additionally, Applicants argued that claim 12, which links Groups 5-7 is patentable and thus represents a contribution over prior art, for this reason Applicants stated that the linking claims and all the claims set forth in Groups 5-7 should be examined together. This is not found persuasive because Applicants have not provided any basis for stating that claim 12 is free of the prior art, the search report provided on the record of this application cites several references as "X" references for claim 12, and there is no discussion set forth in the reply filed 4-27-2009 to support this assertion, therefore Applicant's assertions are not accepted as fact. As stated in the initial Election/Restriction, Chung et al. (2000), as per CFR § 1.475(d), since the instant claims are drawn to multiple categories of invention since the claims recite multiple patentably distinct products and methods, the instant claims are considered to lack unity of invention.

3. Furthermore, the prior art teaches the technical feature associated with groups 1-11, specifically wherein the claims encompass, pharmaceutical compositions comprising at least one compound capable of increasing gap-junction communication, and at least one nucleoside analogue, wherein said enhancing gap-junction communication is an aromatic acid, and further wherein the composition is used for the treatment of cancer in a patient. See for example Chung et al. (2000) which teaches a method for treating nasopharyngeal carcinoma comprising administering phenylbutyrate and ganciclovir, see abstract. Therefore, since groups 1-11 do not share a special technical feature that makes a contribution over the prior art, the instant groups are considered to lack unity of invention.

4. However, upon further inspection of the claims, it was concluded that the initial Election/Restriction was incomplete since it did not include a requirement that Applicants elect a single amino acid sequence from among SEQ ID NO: 1-17 as set forth in claim 24 of the elected invention. On 07/06/2009, Applicant's representative at BICH, STEWART, KOLASCH & BIRCH, LLP was contacted to request a telephonic election of an amino acid sequence for search purposes. However, no election was made and Applicant's requested that this additional sequence restriction would be placed on the record.

5. Claims 24-25 recite multiple amino acid sequences, SEQ ID NO: 1-17 is recited in claim 24 and SEQ ID NO: 1-5 is recited in claim 25. The specification as filed does not set forth a common structure shared among these sequences, therefore each sequence would require a separate search and consideration of the prior art.

6. Furthermore, a search of more than one (1) of the amino acid sequences recited in claims 24-25 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed amino acid sequences. In view of the foregoing, one (1) amino acid sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicants are required to elect one (1) amino acid sequence from claims 24-25.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. During a conversation with Applicant's representative on 07/06/2009, the examiner offered to search up to five sequences from the group of SEQ ID NO: 1-17. Applicants are therefore requested to elect up to five sequences for search purposes.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Smith whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Weitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet L. Epps-Smith/  
Primary Examiner, Art Unit 1633